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Subject:  
Your File No.: Your Ref. No. 41822.2

**FROM**

Name: James J. Boyle  
Phone No.: 571-203-2724  
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# Pages (incl. this): 9  
Date: Sept. 25, 2002  
Our File No.: 07447.0061

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JAMES.BOYLE@FINNEGAN.COM

September 25, 2002

Glen E. Schumann, Esq.  
Moss & Barnett  
4800 Wells Fargo Center  
Minneapolis, MN 55402-4129

**VIA FACSIMILE**

U.S. Patent Application Serial No. 09/887,528  
Our Reference: 07744.0061-00000  
Your Reference: 41822.2

Dear Glen:

Pursuant to our March 13, 2002 letter to you, we filed a petition under 37 CFR 1.47 in the above-captioned case in the U.S. Patent and Trademark Office on March 18, 2002. With this letter, we enclose a copy of the Decision dismissing the petition as inappropriate. The attached Decision also serves as a Supplemental Notice to File Missing Parts, setting a two-month extension from September 3, 2002 in which to supply a properly executed Declaration by joint inventor Michael A. Ekhaus. Accordingly, as set forth in more detail below, please forward to us a properly executed Declaration for the above-captioned application or let us know your response to this request by October 28, 2002.

We have also enclosed with this letter a copy of a Declaration for Mr. Ekhaus to execute in a form that complies with the statutes and regulations. We note, further to your March 7, 2002 facsimile, that Mr. Ekhaus previously refused to execute this form of the Declaration.

As set forth in the attached Decision:

[s]hould Mr. Ekhaus, notwithstanding the extra time that has now elapsed (some 6 additional months) for him to review and understand the instant application papers still decline to execute a declaration in compliance with the statutes and the regulations, then

the circumstances surrounding any continued refusal to properly "join" in this application should be recounted, and petitioner may then obtain relief under the provisions of 37 C.F.R. 1.47 and 35 U.S.C. § 116. The consequences of acceptance of this application in MPEP 409.03(i) and (j), should be made clear to Mr. Ekhaus.

Below, for your reference, we reproduce the portions of MPEP 409.03(i) and (j) cited in the attached Decision:

**409.03(i) Rights of the Nonsigning Inventor**

The nonsigning inventor (also referred to as an "inventor designee") may protest his or her designation as an inventor. The nonsigning inventor is entitled to inspect any paper in the application, order copies thereof at the price set forth in 37 CFR 1.19, and make his or her position of record in the file wrapper of the application. Alternatively, the nonsigning inventor may arrange to do any of the preceding through a registered patent attorney or agent.

While the U.S. Patent and Trademark Office will grant the nonsigning inventor access to the application, *inter partes* proceedings will not be instituted in 37 CFR 1.47 case. *In re Hough*, 108 USPQ 89 (Comm'r Pat. 1955). A nonsigning inventor is not entitled to a hearing (*Cogar v. Schuyler*, 464 F.2d 747, 173 USPQ 389 (D.C. Cir. 1972)), and is not entitled to prosecute the application if status under 37 CFR 1.47 has been accorded, or if proprietary interest of the 37 CFR 1.47(b) applicant has been shown to the satisfaction of the U.S. Patent and Trademark Office.

A nonsigning inventor may join in a 37 CFR 1.47 application. To join in the application, the nonsigning inventor must file an appropriate 37 CFR 1.63 oath or declaration. Even if the nonsigning inventor joins in the application, he or she cannot revoke or give a power of attorney without agreement of the 37 CFR 1.47 applicant.

The rights of a nonsigning inventor are protected by the fact that the patent resulting from an application filed under 37 CFR 1.47(b) and 35 U.S.C. 118 must issue to the inventor, and in an application filed under 37 CFR 1.47(a) and 35 U.S.C. 116, the inventor has the same rights that he or she would have if he or she had joined in the application. *In re Hough*, 108 USPQ 89 (Comm'r Pat. 1955).

If a nonsigning inventor feels that he or she is the sole inventor of an invention claimed in a 37 CFR 1.47 application naming him or her as a joint inventor, the nonsigning inventor may file his or her own application and request that his or her application be placed in interference with the 37 CFR 1.47 application. If the claims in both the nonsigning inventor's application and the 37 CFR 1.47 application are otherwise found allowable, an interference may be declared.

Glen E. Schumann, Esq.  
September 25, 2002  
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**409.03(j) Action Following Acceptance of a 37 CFR 1.47 Application**

After an application deposited pursuant to 37 CFR 1.47 is found acceptable by the Office, the examiner will act on the application in the usual manner. Papers filed by an inventor who did not originally join in the application, and papers relating to its 37 CFR 1.47 status, will be placed in the file wrapper.

In the event the previously nonsigning inventor decides to join in the application by filing an executed oath or declaration complying with 37 CFR 1.63, the oath or declaration will be placed in the application file.

When the examiner determines that an application in which a petition under 37 CFR 1.47 has been granted, or either a continued prosecution application (CPA) filed under 37 CFR 1.53(d) or a file wrapper continuing application filed under former 37 CFR 1.62 thereof is allowable, he or she must check the file wrapper or the PALM bib-data sheet to make sure that the phrase "Rule 47" appears under the filing date. If the phrase "Rule 47" does not appear under the filing date, the examiner should write in black ink the phrase "Rule 47" under the filing date. The examiner will then prepare the application for allowance in accordance with MPEP Chapter 1300. It will not be necessary to forward the application to the Office of Petitions.

A patent granted on an application accepted under 37 CFR 1.47 will have an indication on the face of the patent that the application was filed under 37 CFR 1.47, regardless of whether proper joinder of the previously nonsigning inventor has been made.

An application filed under 37 CFR 1.47 can be published as a Statutory Invention Registration.

As noted in our March 13, 2002 letter, we remind Mr. Ekhaus that U.S. patent laws provide that the inventors and all persons who actively participate in the preparation of a patent application have an obligation to inform the Patent Office of all material prior art of which they are aware. As part of this continuing obligation, we request Mr. Ekhaus to provide us with any information or references which he considers to be material to the examination of the Application.

We look forward to your response by October 28, 2002. If we do not hear from you by this date, we will proceed with the filing of a renewed petition for the acceptance the

Glen E. Schumann, Esq.  
September 25, 2002  
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above-captioned application under 37 C.F.R. 1.47. If you have any questions, please contact me immediately.

Sincerely,



James J. Boyle

JJB/bad

cc:   Teresa J. Dery, Esq.  
Corporate Counsel  
Net Perceptions, Inc.  
7700 France Avenue South  
Edina, MN 55435



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Paper No. 8

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SEP 03 2002

OFFICE OF PETITIONS

In re Application of  
Michael A. Ekhaus et al  
Application No. 09/887,528  
Filed: June 25, 2001  
Attorney Docket No. 7744.0061

:DECISION DISMISSING PETITION  
:UNDER 37 CFR 1.47(a) AS  
:INAPPROPRIATE AND NOTICE TO  
:FILE MISSING PARTS OF NON-  
:PROVISIONAL APPLICATION

This is a decision on the petition under 37 CFR 1.47(a), filed March 18, 2002.

The petition is dismissed as inappropriate.

The instant application was filed on June 25, 2001, without an executed oath or declaration and filing fees. Accordingly, on August 16, 2001, the Office of Initial Patent Examination mailed a Notice to File Missing Parts of Nonprovisional Application requiring the submission of an executed oath or declaration, filing fees, and a \$130 surcharge fee for their late submission.

In reply, petitioner (Mr. James J. Boyle), on March 18, 2002, submitted an executed oath or declaration, the filing and surcharge fees, a petition and fee for a five month extension of time, and the instant petition under 37 CFR 1.47(a) to accept a properly executed declaration by joint inventor Michael A. Ekhaus.

Petitioner states that “[a]lthough Mr. Ekhaus was presented with a copy of the above-identified application, including a copy of the figures, and was presented with a copy of a Declaration for the above-identified application, Mr. Ekhaus has refused to join in the application by refusing to execute the Declaration in a form that would comply with 35 U.S.C. § 115 and 37 C.F.R. § 1.63(b)(2).” More specifically, petitioner states that he received a modified version of an executed declaration by joint inventor Ekhaus, which version was not in compliance with the statute and the rules in that the declaration did not include the language stating that Mr. Ekhaus has “reviewed and understands the contents” of the application. In this regard, joint inventor Ekhaus refuses to execute a declaration in compliance with the statute and the rules because Mr. Ekhaus “firmly believes that he may not be the ‘first, original inventor’ of anything contained within the application, and because Mr. Ekhaus has not had the opportunity to fully review the application to the decree [sic] that makes him comfortable with

what is contained therein" and was only willing to sign the declaration recently proposed for signature. Therefore, despite numerous efforts to obtain a properly executed declaration from joint inventor Ekhaus, petitioner states that joint inventor Ekhaus refuses to execute a declaration complying with the statute and the rules.

A petition under 37 CFR 1.47(a) is inapplicable to the instant case since Mr. Ekhaus has signed a declaration, albeit not complying with the statute and the rules. However, since the declaration executed by Mr. Ekhaus fails to comply with 35 U.S.C. § 115 and 37 CFR 1.63(b)(2), the declaration is not acceptable. Accordingly, the reply to the Notice of August 16, 2001 is considered to be incomplete.

Therefore, since the reply submitted was a *bona fide* effort to supply a complete reply to the Notice of August 16, 2001, and in order to allow joint inventor Ekhaus sufficient time to review the application papers and provide a properly executed declaration, this decision acts as a Supplemental Notice to File Missing Parts of Nonprovisional Application. Accordingly, a period of two months is set within which to supply a properly executed declaration by joint inventor Ekhaus. This period is extendable pursuant to the provisions of 37 CFR 1.136(a). Failure to file a proper reply will result in the abandonment of this application.

Should Mr. Ekhaus, notwithstanding the extra time that has now elapsed (some 6 additional months) for him to review and understand the instant application papers still decline to execute a declaration in compliance with the statutes and regulations, then the circumstances surrounding any continued refusal to properly "join" in this application should be recounted, and petitioner may then obtain relief under the provisions of 37 CFR 1.47 and 35 U.S.C. § 116. The consequences of acceptance of this application under that regulation and statute as to any nonsigning inventor, as recounted in MPEP 409.03(i) and (j), should be made clear to Mr. Ekhaus.

This application is being forwarded to the Office of Initial Patent Examination to await a reply to the Supplemental Notice to File Missing Parts incorporated in this decision.

*Frances Hicks*  
Frances Hicks  
Petitions Examiner  
Office of Petitions  
Office of the Deputy Commissioner  
for Patent Examination Policy  
(703) 305-8680

Conferree: Brian E. Hearn  
*bh*

## DECLARATION AND POWER OF ATTORNEY

As a below named inventor, I hereby declare that: my residence, post office address and citizenship are as stated below next to my name; I believe I am the original, first, and sole inventor (if only one name is listed below) or an original, first, and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled: METHOD AND SYSTEM FOR HIGH PERFORMANCE MODEL-BASED PERSONALIZATION the specification of which  is attached and/or  was filed on June 25, 2001 as United States Application Serial No. 09/887,528 or PCT International Application No. \_\_\_\_\_ and was amended on \_\_\_\_\_ (if applicable).

I hereby state that I have reviewed and understand the contents of the above-identified specification, including the claims, as amended by any amendment referred to above. I acknowledge the duty to disclose information which is material to patentability as defined in 37 CFR § 1.56.

I hereby claim foreign priority benefits under 35 U.S.C. § 119(a)-(d) or § 365(b) of any foreign application(s) for patent or inventor's certificate or § 365(a) of any PCT international application(s) designating at least one country other than the United States, listed below and have also identified below, any foreign application(s) for patent or inventor's certificate, or any PCT International application(s) having a filing date before that of the application(s) of which priority is claimed:

Country	Application Number	Date of Filing	Priority Claimed Under 35 U.S.C. 119
			<input type="checkbox"/> YES <input type="checkbox"/> NO
			<input type="checkbox"/> YES <input type="checkbox"/> NO

I hereby claim the benefit under 35 U.S.C. § 119(e) of any United States provisional application(s) listed below:

Application Number	Date of Filing
60/213,528	June 23, 2000

I hereby claim the benefit under 35 U.S.C. § 120 of any United States application(s) or § 365(c) of any PCT International application(s) designating the United States, listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States or PCT International application(s) in the manner provided by the first paragraph of 35 U.S.C. § 112, I acknowledge the duty to disclose information which is material to patentability as defined in 37 CFR § 1.56 which became available between the filing date of the prior application(s) and the national or PCT International filing date of this application:

Application Number	Date of Filing	Status (Patented, Pending, Abandoned)

I hereby appoint the following attorney and/or agent(s) to prosecute this application and transact all business in the Patent and Trademark Office connected therewith. FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, L.L.P., CUSTOMER NUMBER 22,852, Douglas B. Henderson, Reg. No. 20,291; Ford F. Farabow, Jr., Reg. No. 20,630; Arthur S. Garrett, Reg. No. 20,338; Donald R. Dunner, Reg. No. 19,073; Brian G. Brunsbold, Reg. No. 22,593; Tipton D. Jennings, IV, Reg. No. 20,645; Jerry D. Voight, Reg. No. 23,020; Laurence R. Hefter, Reg. No. 20,827; Kenneth E. Payne, Reg. No. 23,098; Herbert H. Mintz, Reg. No. 26,691; C. Larry O'Rourke, Reg. No. 26,014; Albert J. Santorelli, Reg. No. 22,610; Michael C. Elmer, Reg. No. 25,857; Richard H. Smith, Reg. No. 20,609; Stephen L. Peterson, Reg. No. 26,325; John M. Romary, Reg. No. 26,331; Bruce C. Zoller, Reg. No. 27,680; Dennis P. O'Reilly, Reg. No. 27,932; Allen M. Sokal, Reg. No. 26,695; Robert D. Bajefsky, Reg. No. 25,387; Richard L. Stroup, Reg. No. 28,478; David W. Hill, Reg. No. 28,220; Thomas L. Irving, Reg. No. 28,619; Charles E. Lipsey, Reg. No. 28,165; Thomas W. Winland, Reg. No. 27,605; Basil J. Lewis, Reg. No. 28,818; Martin I. Fuchs, Reg. No. 28,508; E. Robert Yoches, Reg. No. 30,120; Barry W. Graham, Reg. No. 29,924; Susan Haberman Griffen, Reg. No. 30,907; Richard B. Racine, Reg. No. 30,415; Thomas H. Jenkins, Reg. No. 30,857; Robert E. Converse, Jr., Reg. No. 27,432; Clair X. Mullen, Jr., Reg. No. 20,348; Christopher P. Foley, Reg. No. 31,354; John C. Paul, Reg. No. 30,413; Roger D. Taylor, Reg. No. 28,992; David M. Kelly, Reg. No. 30,953; Kenneth J. Meyers, Reg. No. 25,146; Carol P. Einaudi, Reg. No. 32,220; Walter Y. Boyd, Jr., Reg. No. 31,738; Steven M. Anzalone, Reg. No. 32,095; Jean B. Fordis, Reg. No. 32,984; Barbara C. McCurdy, Reg. No. 32,120; James K. Hammond, Reg. No. 31,964; Richard V. Burgujian, Reg. No. 31,744; J. Michael Jakes, Reg. No. 32,824; Thomas W. Banks, Reg. No. 32,719; Christopher P. Isaac, Reg. No. 32,616; Bryan C. Diner, Reg. No. 32,409; M. Paul Barker, Reg. No. 32,013; Andrew Chanho Sonu, Reg. No. 33,457; David S. Forman, Reg. No. 33,694; Vincent P. Kovalick, Reg. No. 32,867; James W. Edmondson, Reg. No. 33,871; Michael R. McGurk, Reg. No. 32,045; Joann M. Neth, Reg. No. 36,363; Gerson S. Panitch, Reg. No. 33,751; Cheri M. Taylor, Reg. No. 33,216; Charles E. Van Horn, Reg. No. 40,266; Linda A. Wadler, Reg. No. 33,218; Jeffrey A. Berkowitz, Reg. No. 36,743; Michael R. Kelly, Reg. No. 33,921; James B. Monroe, Reg. No. 33,971; Doris Johnson Hines, Reg. No. 34,629; Allen R. Jensen, Reg. No. 28,224; Lori Ann Johnson, Reg. No. 34,498; and David A. Manspeizer, Reg. No. 37,540 and [Text]. Please address all correspondence to FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, L.L.P., 1300 I Street, N.W., Washington, D.C. 20005, Telephone No. (202) 408-4000.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Full Name of First Inventor Michael A. Ekhaus	Inventor's Signature	Date
Residence 315 Washington Avenue, Hopkins, MN 55343	Citizenship U.S.A.	
Post Office Address 315 Washington Avenue, Hopkins, MN 55343		

Full Name of Second Inventor Robert Driskill	Inventor's Signature	Date
Residence 5890 66 <sup>th</sup> Lane North, Greenfield, MN 55357	Citizenship U.S.A.	
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Full Name of Third Inventor Filip Mulier	Inventor's Signature	Date
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